UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,459	05/06/2004	Yishai Hornbacher	MLKS.P-004	3458

21121 7590 10/04/2005

OPPEDAHL AND LARSON LLP
P O BOX 5068
DILLON, CO 80435-5068

EXAMINER	
OUELLETTE, JONATHAN P	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,459	HORNBACHER ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-89* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-89* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

3. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an

invention is eligible for a patent is to determine if the invention is within the "technological arts".

4. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
5. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

6. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

7. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under

the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

8. Claims 1-89 appear to be describing a method for ensuring supplied ingredients are organic and for managing organic certification expirations. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.

9. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Star-K (www.star-k.com, retrieved from Internet Archive Wayback Machine <www.archive.org>, Date Range: 6/17/2001-3/8/2002) in view of QAI (Quality

Assurance International, www.qai-inc.com, retrieved from Internet Archive Wayback Machine <www.archive.org>, Date: 2/7/2003).

12. As per **independent Claims 1, 13, 30, 42, 54, 66, and 78**, Star-K discloses a method for use in connection with a first entity, first and second customers of the first entity, and a multiplicity of suppliers of the customers, the method comprising the steps of: by the first entity, receiving from the first customer of the first entity a first ingredient list (pg.5), the first ingredient list comprising ingredients, at least one of which requires a specialty certificate, and for ingredient requiring a certificate, either contact information for a respective supplier of the ingredient or a unique identifier (ingredient name) associated with the ingredient (pg.5, ingredient and supplier information); by the first entity, contacting the respective supplier for each ingredient of the first ingredient list requiring a certificate for which contact information is provided, and requesting a unique identifier associated with the ingredient or a copy of a letter for the ingredient (pg.5, pgs.7-10, Star-K completes detailed evaluation of ingredients); for each ingredient of the first ingredient list requiring a certificate for which contact information was provided, in the event that a copy of the requested letter is received by the first entity, assigning by the first entity a unique identifier associated with said ingredient and communicating the unique identifier to the respective supplier (pgs.7-10, ingredient is added to the approved listing).
13. Star-K fails to expressly disclose by the first entity, receiving from the second customer of the first entity a second ingredient list, the second ingredient list comprising ingredients at least one of which requires a specialty certificate, and for each ingredient requiring a certificate, contact information for a respective supplier of the ingredient or a

unique identifier associated with the ingredient; by the first entity, contacting the respective supplier for each ingredient of the second ingredient list requiring a certificate and requesting either a copy of a letter for the ingredient or a unique identifier for the ingredient; for each ingredient of the second ingredient list requiring a certificate for which contact information is provided, [receiving by the first entity the copy of the requested letter] in the event that a unique identifier is received by the first entity, storing , by the first entity the unique identifier.

14. However, this would simply be a matter of repeating the business process as additional ingredients arise, and Star-K does disclose updating/maintaining the kosher (specialty) certified listing (Pg.8, Pg.10, Ongoing Relationship)

15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving from the second customer of the first entity a second ingredient list, the second ingredient list comprising ingredients at least one of which requires a specialty certificate, and for each ingredient requiring a certificate, contact information for a respective supplier of the ingredient or a unique identifier associated with the ingredient; by the first entity, contacting the respective supplier for each ingredient of the second ingredient list requiring a certificate and requesting either a copy of a letter for the ingredient or a unique identifier for the ingredient; for each ingredient of the second ingredient list requiring a certificate for which contact information is provided, [receiving by the first entity the copy of the requested letter] in the event that a unique identifier is received by the first entity, storing , by the first entity the unique identifier, in the system disclosed by Star-K, for the

advantage of providing a method of managing the certification of ingredient suppliers, with the ability to increase system effectively/efficiency, by maintaining the system/process as new ingredients become part of the customer program.

16. Star-K also fails to expressly disclose wherein the certification/certificate is for certifying organic ingredients.

17. However, QAI discloses performing certification for products with organic content (pgs.4-8).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the certification/certificate is for certifying organic ingredients, as disclosed by QAI, in the system disclosed by Star-K, for the advantage of providing a method of managing the certification of ingredient suppliers, with the ability to increase system effectively/efficiency by using the system/method with a variety of specialty ingredient certification programs.

19. As per Claims 2, 14, 31, 43, 55, 67, 79, Star-K and QAI disclose for each ingredient in the first ingredient list requiring a organic certificate, communicating the unique identifier back to the first customer (certified listing).

20. As per Claims 3, 15, 32, 44, 56, 68, 80, Star-K and QAI disclose for each ingredient in the first ingredient list requiring a organic certificate, communicating the unique identifier back to a certification agency (certified listing).

21. As per Claims 4, 16, 33, 45, 57, 69, 81, Star-K and QAI disclose for each ingredient in the first ingredient list requiring a organic certificate, communicating the unique

identifier back to the first customer and to a organic certification agency (certified listing).

22. As per Claims 5, 6, 17, 18, 34, 35, 46, 47, 58, 59, 70, 71, 82, and 83, Star-K and QAI fails to expressly disclose wherein the contact information comprises an email address or fax number.

23. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method of managing the certification of ingredient suppliers would be performed regardless of the type of contact information used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to maintain a multitude of supplier contact information types (name, e-mail, address, telephone number, fax number), because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

25. As per Claims 7, 19, 36, 48, 60, 72, 84, Star-K and QAI disclose fail to expressly disclose wherein the first entity is not an organic certification agency.

26. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made for any third party administrator to perform the certification assurance method, although efficiencies could be achieved by the certification agency performing the method as described in the prior art.

27. As per Claims 8, 20, 37, 49, 61, 73, 85, Star-K and QAI disclose wherein each organic letter has an associated expiration date (inherent to organic certifications).

28. Star-K and QAI fail to expressly disclose identifying, by the first entity, organic letters that will expire or have expired; for each identified organic letter, contacting the supplier associated therewith and asking for a new organic letter.

29. However, Star-K does disclose maintaining and updated listing of organic certified products (ingredients), which would entail yearly ingredient analysis/ review of ingredients (pg.10)

30. As per Claims 9, 21, 38, 50, 62, 74, 86, Star-K and QAI disclose for at least one identified (expired) organic letter, receiving the new organic letter (updating certification listings).

31. As per Claims 10, 22, 39, 51, 63, 75, 87, Star-K and QAI disclose communicating the new organic letter to the first customer (updating certification listings).

32. As per Claims 11, 23, 40, 52, 64, 76, 88, Star-K discloses communicating the new organic letter to a certification agency (updating certification listings).

33. As per Claims 12, 24, 41, 53, 65, 77, 89, Star-K and QAI disclose communicating the new organic letter to the first customer; and communicating the new organic letter to a certification agency (updating certification listings).

34. As per **independent Claim 25**, Star-K discloses a method for use in connection with a first entity and myriad ingredients, each ingredient supplied by a respective supplier (pg.5), each having an associated specialty letter having a respective expiration date

(inherent to specialty certifications), each ingredient having an associated unique identifier assigned by the first entity (certification listing, name – database identifier).

35. Star-K fails to expressly disclose identifying, by the first entity, specialty letters that will expire or have expired; for each identified specialty letter, contacting the supplier associated therewith and asking for a new specialty letter.

36. However, Star-K does disclose maintaining and updated listing of kosher (specialty) certified products (ingredients), which would entail yearly ingredient analysis (pg.10).

37. Star-K also fails to expressly disclose wherein the certification/certificate is for certifying organic ingredients.

38. However, QAI discloses performing certification for products with organic content.

39. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the certification/certificate is for certifying organic ingredients, as disclosed by QAI, in the system disclosed by Star-K, for the advantage of providing a method of managing the certification of ingredient suppliers, with the ability to increase system effectively/efficiency by using the system/method with a variety of specialty ingredient certification programs.

40. As per Claim 26, Star-K and QAI disclose for at least one of the identified (expired) organic letters, receiving the new organic letter (renewed ingredient analysis).

41. As per Claim 27, Star-K and QAI disclose communicating the new organic letter to a customer (renewed ingredient analysis).

42. As per Claim 28, Star-K and QAI disclose communicating the new organic letter to a certification agency (renewed ingredient analysis).

43. As per Claim 29, Star-K and QAI disclose communicating the new organic letter to a customer; and communicating the new organic letter to a certification agency (renewed ingredient analysis).

Conclusion

44. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

45. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

48. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

September 27, 2005

Jonathan Ouellette
Patent Examiner
Technology Center 3600